

PHILADELPHIA  
ATLANTA  
CHARLOTTE  
CHERRY HILL  
CHICAGO  
DALLAS  
DENVER  
LAS VEGAS  
LONDON  
LOS ANGELES



A PROFESSIONAL CORPORATION

**RECEIVED**  
**CENTRAL FAX CENTER**  
**JUL 08 2005**

NEWARK  
NEW YORK  
SAN DIEGO  
SAN FRANCISCO  
SEATTLE  
TRENTON  
WASHINGTON, DC  
WEST CONSHOHOCKEN  
WICHITA  
WILMINGTON

1900 MARKET STREET PHILADELPHIA, PA 19103-3508 215.665.2000 800.523.2900 215.665.2013 FAX www.cozen.com

Ser. No.: 10/757,298 Filing Date: January 14, 2004 Docket No. ISIS0038-100 (CHEM0001US)  
Matter No.: 147319  
Title: Modified Oligonucleotides For Use In Gene Modulation Pages to Follow: 4  
Sender's Name: Paul K. Legaard, Ph.D. Date: July 8, 2005

RECIPIENT(S)	COMPANY/FIRM	FAX
Tracy Ann Vivlemore	USPTO, GAU 1635	(703) 872-9306

MESSAGE: OFFICIAL FAX

PLEASE DELIVER TO EXAMINER VIVLEMORE.

**ATTACHED IS:**

1. Transmittal Form (1 page); and
2. Response to the Restriction Requirement (3 pages).

**IF YOU DO NOT RECEIVE ALL PAGES, PLEASE CALL 215.665.2000 or 800.523.2900 IMMEDIATELY.**

THIS TRANSMISSION IS ALSO BEING SENT VIA:

- ☐ Regular Mail
- ☐ Certified Mail
- ☐ Hand Delivery
- ☐ Overnight Mail
- ☐ Federal Express

**NOTICE**

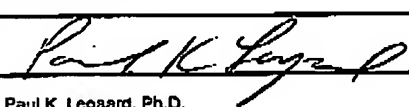
The information contained in this transmission is privileged and confidential. It is intended for the use of the individual or entity named above. If the reader of this message is not the intended addressee, the reader is hereby notified that any consideration, dissemination or duplication of this communication is strictly prohibited. If the addressee has received this communication in error, please return this transmission to us at the above address by mail. We will reimburse you for postage. In addition, if this communication was received in the U.S., please notify us immediately by phoning and asking for the Fax Center.

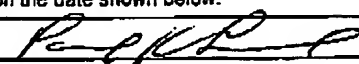
Approved for use through 07/31/2008. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)		Application Number	10/757,298
		Filing Date	January 14, 2004
		First Named Inventor	Robert S. Andrews
		Art Unit	1835
		Examiner Name	Tracy Ann Vivemore
Total Number of Pages in This Submission	4	Attorney Docket Number	ISIS0038-100 (CHEM0001US)

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<div style="border: 1px solid black; padding: 2px;">Remarks</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	Cozen O'Connor		
Signature			
Printed Name	Paul K. Legaard, Ph.D.		
Date	8 July 2005	Reg. No.	38,534

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Signature			
Typed or printed name	Paul K. Legaard, Ph.D.	Date	8 July 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PYO-6199 and select option 2.

RECEIVED  
CENTRAL FAX CENTER

JUL 08 2005

DOCKET NO.: ISIS0038-100 (CHEM0001US)

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Andrews, Boswell, and Ward

Serial No.: 10/757,298

Group Art Unit: 1635

Filed: January 14, 2004

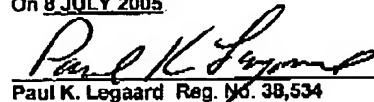
Examiner: Tracy Ann Vivlemore

Title: **MODIFIED OLIGONUCLEOTIDES FOR USE IN GENE MODULATION**

## Certificate of Facsimile Transmission

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office to facsimile number (703) 872-9306 on the date shown below.

On 8 JULY 2005



Paul K. Legaard Reg. No. 38,534

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**RESPONSE TO THE RESTRICTION REQUIREMENT**

The present Response is filed in regard to the Restriction Requirement mailed June 28, 2005 in connection with the above-identified patent application.

The Examiner has mistakenly restricted claims 1-40 into sixteen (16) groups. Applicants elect Group I, containing claims 1-5, 8-12, and 38 with traverse.

The Office Action asserts that Groups I-XIII are unrelated because the compounds claimed therewithin, which are oligomeric compounds comprising a protected phosphate group, have "different chemical structures" and "different effects" such as "differing levels of nuclease resistance or differing chemical reactivities." That the compounds in each of the designated thirteen groups comprise "different chemical structures", however, is of no consequence in a restriction requirement analysis. Indeed, if compounds having "different chemical structures" were to be taken into account in such an analysis, then only one compound per application would be mandated. Such a result, fortunately, is not provided within the MPEP. In addition, whether or

DOCKET NO.: ISIS0038-100 (CHEM0001US)

PATENT

not a compound would have a different level of any particular activity compared to another compound also has no bearing in a restriction requirement analysis. The proper analysis is whether the compounds would have "different effects" not different levels of a particular effect. Indeed, it is quite possible that two compounds in the same Group may differ in the level of nuclease resistance (e.g, one compound in a particular group may have a half-life that is 2% longer than another compound in the same group). Thus, the reasons provided in the Office Action do not support restriction between Groups I-XIII.

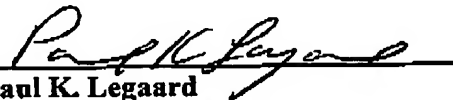
Even if the Office Action still considers the thirteen groups of claims to be patentably distinct, §803 of the M.P.E.P. mandates two criteria for a proper requirement for restriction: 1) the inventions must be independent or distinct; and 2) there must be a serious burden on the examiner. Use of different "keywords" in searching does not constitute a "serious burden." Rather, for purposes of initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in M.P.E.P. §808.02. Significantly, the Examiner has not met the *prima facie* burden. Indeed, the Examiner has not shown separate status in the art or a requirement for a different field of search. Further, each of the thirteen groups of claims has, in fact, been classified into identical classes (class 536) and subclasses (subclass 24.5), thus, strongly indicating a lack of serious burden. Accordingly, claims 1-33 and 38 should be examined together in the present application without restriction.

If the Office Action persists in applying the present restriction, Applicants presume that any prior art that is found relating to one particular protected phosphate group, to the extent that such prior art exists, will not be used in an obviousness rejection against a compound having a different protected phosphate group.

**DOCKET NO.: ISIS0038-100 (CHEM0001US)****PATENT**

Applicants submit that the present response is complete and complies with the requirements of 35 U.S.C. §121. In addition, Applicants submit that, at a minimum, claims 1-33 and 38 must be considered in the present application without restriction.

Respectfully submitted,

  
Paul K. Legaard  
Registration No. 38,534

Date: 8 July 2005

COZEN O'CONNOR  
1900 Market Street  
Philadelphia, PA 19103-3508  
Telephone: (215) 665-6914  
Facsimile: (215) 701-2141